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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,834	10/21/2005	Hiroto Kidokoro	071849	3747
38834 7590 01/22/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
BURNEY, RACHEL L				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
01/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,834

**Applicant(s)**

KIDOKORO, HIROTO

**Examiner**

Rachel L. Burney

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-13 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 10-13, and 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 6365313, Masuo et al.

With respect to claims 1 and 18, Masuo discloses a toner (column 2, line 51), comprising a solvent in the polymerization process (a binder resin) which may be aliphatic hydrocarbon compounds (column 7, lines 1-3), which is the same binder resin used in the instant specification, and would therefore have the same properties, such as being a negative charge control resin (see page 10, line 22 –

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page 11, line 10) and a pigment (column 10, lines 2-13), which may be C.I.

Pigment Yellow 180 (column 10, lines 19-20), which is the same pigment used in the instant application (see page 15, line 26 – page 16, line 3). Masuo does not disclose the maximum absorption rates of a filtrate of the toner, but the instant specification indicates that the absorption rates are based on the pigments used (see page 27, line 14 - page 28, line 13). Because Masuo teaches a similar toner with the same pigment, it would be reasonable to conclude that the maximum absorption rate of a filtrate would fall within the same range.

With respect to claims 2 and 10, Masuo further discloses that the toner has a volume average particle diameter (dv) of 0.5-20  $\mu\text{m}$ , preferably 3-10  $\mu\text{m}$  and a ratio of dv/dp, the number average particle diameter of less than 2.0, preferably less than 1.4 (column 14, lines 33-41). Masuo does not disclose the ratio of the length to the breadth of the toner or the filtrate ratio of the area of a region where the molecular weight exceeds 2,000 to the area of a region where the molecular weight is from 500 to 2,000, however because Masuo discloses a similar toner particle with a similar particle diameter distribution, it would be reasonable to conclude that the other measurements of the molecular weight distribution would also be similar.

With respect to claim 3, Masuo does not teach the basicity of a filtrate of the toner, however because Masuo teaches a similar toner, it would be reasonable to conclude that the filtrate of the toner would have similar properties.

With respect to claims 4 and 5, Masuo further discloses that the toner comprises a charge control agent consists of a copolymer (charge control resin) having a weight average molecular weight of 25,000 to 40,000 (column 3, lines 26-35).

With respect to claims 6 and 7, Masuo further discloses that the toner comprises a parting agent, which may be pentaerythritol tetramyristate or pentaerythritol tetrapalmitate (column 11, line 65 – column 12, line 26), which are the multifunctional ester parting agents of the instant application (see page 24, lines 3-6).

With respect to claim 11, Masuo does not disclose the inclusion of a tetrahydrofuran-insoluble content, so it would be reasonable to conclude that it is present in an amount of 0%.

With respect to claim 12, the instant claim does not give a concentration of an aqueous extract solution of the toner, which would affect the pH. Masuo does not teach the pH of an aqueous extract solution of the toner, however because Masuo teaches a similar toner, it would be reasonable to conclude that an aqueous extract solution of the toner would have similar properties.

With respect to claim 13, Masuo teaches that the pigment is present in an amount of 0.1 to 20 parts by weight per 100 parts by weight of the polymerizable monomer (column 10, lines 31-38), but does not teach the concentration as defined by the instant application. Applicant's Example 1 shows that the pigment is present in about 4% by weight of the toner. The pigment of Masuo is present in the same

amount as that of the instant application, therefore it would be reasonable to conclude that the concentrations would also be the same.

With respect to claims 19 and 20, Masuo teaches that Pigment Red 122 may be used (column 17, lines 55-63). Masuo does not disclose the pH of a dispersion prepared by dispersing 6 g of the pigment into 100 g of water, however because the pigment is the same, a dispersion formed by the same method would have the same pH.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 112***

4. In view of the amendments to the claims, filed 10/174/2008, the rejection to the claims under 35 USC § 112 has been withdrawn.

#### ***Claim Rejections - 35 USC § 102***

5. Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive. Applicant argues that the toner of the instant application is different than the toner of the applied reference because it is prepared by providing master batches of pigment and charge control agent, dissolving them in a polymerizable monomer, and polymerized. The examiner respectfully disagrees. The examiner asserts that the toner

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of Masuo is also made by preparing a mixture and polymerizing the mixture to form toner particles, see Example 1, column 17, line 31 - column 18, line 60). Applicant has failed to show evidence that the toner of Masuo would not have the claimed properties of the instant application. Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/  
Supervisory Patent Examiner, Art Unit 1795

RLB